UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,436	12/29/2000	Bassam A. Saliba	MS1-426USC1	8755

69316   7590   12/12/2007

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ART UNIT	PAPER NUMBER
3691	

MAIL DATE	DELIVERY MODE
12/12/2007	PAPER

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PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/751,436
Filing Date: December 29, 2000
Appellant(s): SALIBA ET AL.

MAILED

DEC 1 2 2007

GROUP 3600

William J. Breen III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 17, 2007 appealing from the

Office action mailed March 26, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| 5,963,925 | KOLLING et al. | 10-1997 |
| 5,930,479 | HALL | 7-1999 |

6,401,079	KAHN et al.	6-2002
6721783	BLOSSMAN et al.	4-2004
6,629,081	CORNELIUS et al.	9-2003
6,678,664	GANESAN	1-2004
5649116	MCCOY et al.	7-1997
6049784	WEATHERLY et al.	4-2000
5,983,200	SLOTZNICK	11-1999
6,442,529	KRISHAN et al.	8-2002

Microsoft Computer Dictionary, 1997, Third Edition, pp. 173-174.

Wells Fargo Online, Retrieved on May 23, 2004 from www.archive.org's link to

www.wellsfargo.com, web pages from 12/02/98 and 10/01/98.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   **Claims 1, 2, 8-19, 25, 28, 36, 37, 39, 40, 43 & 52 are rejected under 35**

U.S.C. 102(e) as being anticipated by Kolling et al. (US Patent 5,963,925, hereafter

Kolling).

Re. Claim 1, Kolling anticipates a method comprising:

- receiving bill data (Col. 8, ll. 52-53); and

- generating an email message with information including at least a portion of the received bill data (1. Email message: a) Email is short for "electronic mail". Electronic mail or email is defined by the Microsoft Computer Dictionary as "1. The exchange of text messages and computer files over a communications network, such as a local area network or the Internet, usually between computers or terminals. 2. "An electronic text message". The Electronic Payment System (EPS) is one such email system – Abstract, ll. 1-7; Col. 5, ll. 39-47; Col. 22, ll. 25-34-consumer election of address options can include an e-mail address; Col. 26, ll. 28-29; Col. 30, ll. 40-41. 2. Bill data – Col. 30, ll. 37-48), and

- wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient (Col. 19, ll. 26-28), and

- wherein the recipient can be either a user or a non-user of a secure email system, wherein no non-user has registered for a service of the secure email system (Abstract – "The ESP system operates independently or is an enhancement to any suitable electronic bill payment system." (ll. 7-9.). "A CFI associated with each SGEN delivers each electronic statement to the appropriate customer using a customer identifier in the statement data and uses any chosen medium.".(ll. 28-31); Col. 4, l. 8 – Col. 6, l. 34 and other locations in Kolling.).

EXPOSITION OF KOLLING'S ANTICIPATION of the two last "wherein" statements:

A. Definitions and Assumptions:

(a) Per the Microsoft Dictionary, any electronic delivery of information is considered an email delivery.

(b) Kolling's anticipation is divided into the security aspect of the transmission, the user email aspect presented above, and the enablement of registered users of a secure email system through which users can receive billing information and a non-secure option for enabling non-users of a secure email system to receive billing information.

(c) Email Address for any user – Kolling discloses the option of including an email address in a billing statement for any user. Kolling provides no restriction regarding a

user or non-user of a secure system for he option of including an email address (Col. 19, ll. 26-28).

B. Further EVIDENCE regarding the "Where-in" Limitations.

1.   the recipient can be either a user or a non-user of a secure email system.

        (a) User of a secure email system

This option in Kolling enables a secured system by connecting a secure initial transmission to a secure second transmission which makes the entire transmission of the billing information secure.

The evidence in Kolling is as follows:

(1) The Security aspect:

Secure email delivery of a statement:

Col. 4, ll. 27-29: "Electronic statement presentment provides for security and privacy of the information by transporting and delivering statements through a secure network.".

User participation in a secure email system:

Col. 4, ll. 38-41: "By introducing electronic statement presentment to an existing electronic bill payment system, an added dimension enables fully automated bill payment. In addition, any suitable electronic remote banking service provided by a financial institution is also enhanced. By integrating the ESP system of the present invention into an electronic bill payment system, a fully electronic payment system is provided that enables processing controls, transaction completion certainty and item resolution".

Col. 4, ll. 59-62: "the present invention is able to send electronically a variety of statement and invoice types (or other information products) from a business entity to a consumer".

Col. 5, ll. 12-16: "the present invention allows a biller to enroll in a single ESP system and be assured that electronic statements will be delivered to those of its customers that desire electronic statements, regardless of the customer's choice of financial institution".

Col. 5, II. 42-46: "The task of contacting the consumer and providing the electronic statement in an appropriate medium is left to the consumer financial institution. The consumer financial institution may then use any of a variety of means to transmit this electronic statement to the consumer";

Col. 5, II. 50-52: "For example, banks such as Bank of America and Citibank have their own proprietary systems for communicating with consumers"; 64-67: "In one embodiment, a private telecommunications IP-based intranet serves as a link to consumer financial institutions, such as a bank that provides electronic banking services for its customers". Such an arrangement could be fully secured.

CONCLUSION: In Kolling's secure embodiments, Kolling clearly anticipates the option for a biller to present billing information to a consumer customer user by enabling the secure transmission of billing information to a user's financial institution which in turn can securely transmit the billing information to the customer user. Thus, Kolling anticipates a category of users of a secure email system who are recipients of securely delivered billing information.

(b) Non-user of a secure email system

This anticipated option in Kolling enables a non secured system transmission to a non-user of a secure email system by connecting a secured initial transmission to a non secured second transmission which makes the entire transmission of the billing information non secure by the time it reaches the non-user of a secure network. Kolling anticipates this embodiment by maintaining the option for first sending the billing information through a secure network to an intermediary such a financial institution or another service provider who in turn can choose to send the billing information to a non-user of a secure system through a non secure or less secure network such as the internet.

The evidence in Kolling is as follows:

Col. 5, II. 42-50: "The task of contacting the consumer and providing the electronic statement in an appropriate medium is left to the consumer financial institution. The

consumer financial institution may then use any of a variety of means to transmit this

electronic statement to the consumer. For example, <u>any electronic home banking</u>

<u>service that the consumer financial institution supports may be used to transmit the</u>

<u>electronic statement to the consumer</u>. Electronic means such as the <u>Internet,</u>

<u>telephones, video telephones, televisions, WebTV</u>, personal digital assistants, or any

other proprietary communication system may be used". <u>These options</u> the internet,

telephone, WebTV and pda systems <u>clearly include non-secure email systems</u>.

<u>Col. 5, II. 59-64</u>: "Furthermore, the present invention need not rely upon the Internet

which may at times be slow, unreliable or less secure. Any electronic network may be

used by the present invention to deliver statement information from a biller to provide an

electronic statement to a consumer financial institution.". This disclosure clearly states

that non-secure networks may be used in the Kolling disclosure, while explicitly pointing

out that such networks may be "less secure", meaning not using a secure network. The

"need not rely upon" statement means that he financial institution may choose to rely

upon the internet or other non-secure networks if they so choose. This then means that

the consumer/customer being billed can be using an electronic mail system to receive

billing information while being a "<u>non-user of a secure email system</u>".

2.   <u>no non-user has registered for a service of the secure email system.</u>

The examiner interprets this limitation as applying solely to the context of the particular

electronic billing situation in which some "users" are registered users of the secure

email system who are receiving bills from a biller to electronically transmit billing

information to them. This same biller may also be electronically sending billing

information to the non-users through a financial institution or other service provider

which forwards some aspect or version of the billing information through the internet or

other less secure network to non-users of he secure email system.

<u>Col. 5, II. 12-16</u>: "the present invention allows a biller to enroll in a single ESP system

and be assured that electronic statements will be delivered to those of its customers

that desire electronic statements, regardless of the customer's choice of financial institution".

Col. 5, ll. 52-58:   "The consumer financial institution could even print and deliver the statements if it wished. By allowing a consumer financial institution to use its desired means of communication with a customer, and by integrating the ESP system into this desired means of communication, provides value to the consumer financial institution and to the consumer".

Col. 5, ll. 42-46: "The task of contacting the consumer and providing the electronic statement in an appropriate medium is left to the consumer financial institution. The consumer financial institution may then use any of a variety of means to transmit this electronic statement to the consumer".

GENERAL CONCLUSION OF ANTICIPATION: Kolling anticipates an electronic billing system which is enables receipt of bill data through email by users who are users or non-users of a secure email system wherein no non-user has registered for a service of the secure email system.

Re. Claim 2, Kolling discloses a method according further comprising: sending the email message to the recipient (Col. 30, ll. 37-41).

Re. Claim 8, Kolling discloses a method according further comprising:

- receiving the sent email message including at least a portion of the bill data at the recipients email address (Col. 1, l. 26; Col. 9, ll. 15-16); and

- displaying at least a portion of the message in an inbox of an email client used by the recipient to access their email account (Col. 13, ll. 20-32; Col. 18, ll. 15-16; Col. 30, ll. 37-41).

Re. Claim 10, Kolling discloses a method according further comprising: paying some or all of the received bill by responding to the email (Abstract, ll. 8-9; Col. 4, ll. 30-34, 55-59).

Re. Claim 11, Kolling discloses a data network comprising:

- a plurality of computing devices, coupled to the network, to facilitate network access by one or more participants (Col. 33. l. 23 – Col. 34, l. 33); and

- an email server, coupled to the data network and responsive to one or more of the plurality of computing devices, the email server including: a storage medium to store at least one financial account for each of the plurality of participants (Col. 33. I. 23 – Col. 44, I. 33, see especially the email systems including Exchange Server, CCMail, etc at Col. 33, II. 25-27); and

- a financial transaction manager, coupled to the memory device and selectively invoked by a participant, to manage access to and manipulation of financial account assets to effect requested financial transactions with any network participant or non-participant (Col. 34, II. 35-67).

The balance of the claim language is not given patentable weight for the reasons stated in the above 35 USC 112-2nd paragraph rejection.

Re. Claim 12, Kolling discloses a data network wherein the financial account is electronically linked to an account of the participant at a financial institution (Fig. 1; Col. 4, II. 63-65).

Re. Claim 13, Kolling discloses a data network wherein the account of the participant is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution (Col. 18, I. 58).

Re. Claim 14, Kolling discloses a data network wherein the financial account is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution (Col. 18, I. 58).

Re. Claim 15, Kolling discloses a data network wherein the computing devices are one or more of a personal computer, a personal digital assistant, a kiosk, a telephone and a set-top box having sufficient resources to enable the
participant to access the data server and utilize the financial transaction
manager (Col. 5, II. 47-50; Col. 34, II. 1-14).

Re. Claim 16, Kolling discloses a data network further comprising an email system having a plurality of data servers including the data server (Col. 10, II. 32-34; Col. 14, I. 8-10; Col. 31, II. 59-61; Col. 33, II. 23-29).

Re. Claim 17, Kolling discloses a data network wherein the data server is controlled by a financial institution (Col. 1, ll. 11-15; Col. 5, ll. 42-53).

Re. Claims 18, Kolling discloses a data network wherein the financial transaction manager selectively transfers assets from a first participant's account to a second participant's account in response to a request by the first participant to transfer such assets (Col. 9, ll. 15-25).

Re. Claims 19, Kolling discloses a data network wherein each of the first and second participants are individual consumers, a business, or a combination of each (Col. 4, ll. 55-56, 63-64; Col. 5, ll. 21-24).

Re. Claims 25, Kolling discloses a data network wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service (Col. 9, ll. 15-25).

Re. Claims 28, Kolling discloses a data network wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant (Col. 9, ll. 15-25).

Re. Claim 36, Kolling discloses a storage medium having stored thereon a plurality of executable instructions which, when executed, implement a financial transaction manager according to claim 11 (Fig. 17; Col. 33, l. 42 – Col. 34, l. 34).

Re. Claim 37, Kolling discloses an email system, selectively accessed by users on a data network using a computing device, the email system comprising:

- a user interface, through which a user accesses an account associated with the user (Col. 19, ll. 27-28; Col. 26, ll. 57-59; Col. 25, ll. 10-26; Col. 26, ll. 25-30);

- one or more storage devices, to store and maintain account information for each of the users (after final amendments are underlined) (Col. 33, ll. 43-67); and

- a financial transaction manager, responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the

user to conduct financial transactions with another user or non-user of the email system (Col. 34, ll. 35-67).

The balance of the claim language is not given patentable weight for the reasons stated in the above 35 USC 112-2nd paragraph rejection.

Re. Claim 39, Kolling discloses an email system wherein the user interface is a series of instructions issued to an email client executing on a computing device of the participant (Col. 33, l. 43 – Col. 34, l. 67).

Re. Claim 40, Kolling discloses an email system wherein the financial transaction manager selectively transfers assets from a first user's account to a second user's account in response to a request by the first user to transfer such assets (Col. 9, ll. 15-25).

Re. Claim 43, Kolling discloses an email system wherein each of the first and second users are individual consumers, or businesses (Col. 4, ll. 55-56, 63-64; Col. 5, ll. 21-24).

Re. Claim 49, Kolling discloses an email system wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service (Col. 9, ll. 15-25).

Re. Claim 52, Kolling discloses an email system wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant (Col. 9, ll. 15-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 3-6 & 9 are rejected** under 35 U.S.C. 103(a) as being unpatentable over

Kolling in view of Hall (US Patent 5,930,479) and Kahn et al. (US Patent 6,401,079 B1,
hereafter Kahn).

RE. Claim 3, Kolling discloses a method wherein the step of generating comprises
constructing the email message to include at least a URL (an internet address) of where
bill data may be confidentially viewed (Col. 19, II. 7-13, 26-28; Also Col. 3, II. 40-46).
Disregarding the security status of the intended URL address would have been obvious
to the ordinary practitioner.

Kolling do not explicitly disclose a method wherein the step of generating comprises:

- determining whether the recipient is a participant in a secure email network; and

However, Hall discloses a secure email network (Col. 2, I. 63 – Col. 3, I. 13); and

Further, Kahn discloses determining the characteristics of domains, such as their
security status (Col. 22, II. 15-24).

The ordinary practitioner would have recognized the ubiquitous use of URL's which
provide an opportunity for any operator of a web site, such as a biller or biller agent's
web site, to notify an e-mail user to log on to an internet address (by direct link or not)
for many purposes, such as for viewing secure bill data if the email user's network is of
an unknown security level. Kolling discloses such an arrangement in Col. 3, II. 40-46. An
unknown security condition would be the case if the email user is not registered with the
biller or the biller's agent. It would therefore have been obvious to an ordinary
practitioner of the art at the time of Applicant's invention to have combined the art of
Kolling with that of Hall and Kahn in order to reduce the barriers to increased usage by
individuals and smaller business entities which exist in conventional electronic bill
presentment and/or payment system, motivated by a desire to provide a system and
method for controlling the reception of communications from various entities having
access to the network (Hall, Col. 1, II. 8-10).

3.   **Claims 4-6 & 9 are rejected** under 35 U.S.C. 103(a) as being unpatentable over
Kolling in view of Blossman et al. (US Patent 6,721,783 B1, hereafter Blossman).

Re. Claim 4, Kolling do not explicitly disclose a method further comprising: constructing the email message to include substantially all of the bill data along with financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account. However, Blossman et al. disclose a method according to claim 3, further comprising: constructing the email message to include substantially all of the bill data along with financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account (Col. 4, ll. 41-44, 50-55; Col. 12, ll. 14-47). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Blossman in order to send electronically-mailed financial billing and statement notices or advices and mandated periodic statements, securely or privately (Blossman et al., Col. 3, ll. 55-58).

Re. Claim 5, Kolling disclose a method wherein the MIME elements enable the recipient to pay all or part of the received bill (Col. 3, ll. 14-16. A bill can be paid once it is received by the payer, especially when there is confidence in the integrity of the statement data.).

Re. Claim 6, Kolling disclose a method wherein the MIME elements enable the recipient to establish and manage a financial account (The security features of the MIME elements create greater confidence in the data and in the integrity of the transmissions, thus encouraging the recipient to make a return transmission with payment information).

Re. Claim 9, Kolling disclose a method further comprising: displaying the email message in the email client of the recipient, upon recipient access of the email message, that enable the recipient to pay some or all of the received bill (Abstract, ll. 8-9; Col. 4, ll. 30-34, 38-41, 55-59). Kolling do not explicitly disclose a method wherein the email message includes financial Multipurpose Internet Mail Extension (MIME) elements. However, Blossman disclose a method according to claim 3, further comprising: constructing the email message to include substantially all of the bill data along with financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account (Col. 4, ll. 41-44, 50-55; Col.

12, ll. 14-47). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Blossman et al. in order to send electronically-mailed financial billing and statement notices or advices and mandated periodic statements, securely or privately (Blossman et al., Col. 3, ll. 55-58).

4.   **Claim 7 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Hall and Kahn as applied to claim 3 above, and further in view of Cornelius et al. (US Patent 6,629,081, hereafter Cornelius).
Re. Claim 7, neither Kolling nor Hall explicitly disclose a method, wherein the step of determining comprises:

- identifying a domain name from the email address; and

- cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email system.

However, Cornelius et al. disclose a method, wherein the step of determining comprises: identifying a domain name from the email address (Col. 24, ll. 10-24); and Kahn disclose a method of cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network (Col. 22, ll. 15-24). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling, Hall, Kahn and Cornelius in order to help keep customers' billing data secure in a computer automated billing method, motivated by a desire to provide a system and method for controlling the reception of communications from various entities having access to the network (Hall, Col. 1, ll. 8-10).

5.   **Claims 26, 27, 38, 50, 51 & 59 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Cornelius et al. (US Patent 6,629,081, hereafter Cornelius).

Re. Claims 26&27, Kolling do not explicitly disclose a data network, and an e-mail system, wherein the network service is

- **Re. Claims 26 and 50,** an electronic auction service.
- **Re. Claims 27 and 51,** an electronic retail service.
- **Re. Claim 38,** an email system, wherein the user interface is a series of instructions issued to a computing device of the user to create a web page at the computing device.

However, Cornelius disclose a data network wherein the network service is

- an electronic auction service (Fig. 8; Col. 18, ll. 13-19).
- an electronic retail service (Fig. 3, Col. 3, ll. 65-67).
- an email system wherein the user interface is a series of instructions issued to a computing device of the user to create a web page at the computing device (Col. 192, ll. 21-39; Col. 216, ll. 3-63).

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling with that of Cornelius in order to provide improved statement or billing delivery means to leverage existing systems (such as existing electronic bill payment systems) to participants in a transaction (Kolling, Col. 4, ll. 2-6).

Re. Claim 59, Kolling et al. disclose a storage medium having stored thereon a plurality of executable instructions which, when executed, implement a financial transaction manager of an email system (Fig. 17; Col. 33, l. 42 – Col. 34, l. 34).

6.   **Claims 29, 31, 53 & 55 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Ganesan (US Patent 6,678,664 B1, hereafter Ganesan).

Re. Claims 29 & 53, Kolling do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment. However, Ganesan discloses a data network wherein the financial

transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment (Col. 18, ll. 5-23). Ganesan discloses the standard practice of honoring a check if adequate prior credit arrangements are made. In the electronic banking era these facilities include a line of credit or a credit card account of the payer arranged with the financial institution to back up a payment account such as a checking account. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling with that of Ganesan in order to reduce, if not eliminate the barriers to increased usage by individuals of electronic bill presentment and/or payment systems (Ganesan Col. 4, ll. 11-15).

Re. Claims 31 & 55, Kolling et al. do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment. However, Ganesan discloses a data network wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment (Col. 18, ll. 5-23). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling with that of Ganesan in order to reduce, if not eliminate the barriers to increased usage by individuals of electronic bill presentment and/or payment systems (Ganesan, Col. 4, ll. 11-15).

7.   **Claim 32 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling and Ganesan as applied to claim 31 above, and further in view of Blossman.

Re. Claim 32, neither Kolling nor Ganesan explicitly disclose a data network, wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to honor the requested payment. However, Blossman discloses a data network wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to

honor the requested payment (Col. 9, II. 11-27). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Ganesan with that of Blossman in order to send electronically mailed bank advices of electronic bill presentment and/or payment systems events to individuals (Blossman, Col. 3, II. 55-58).

8.   **Claim 30 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling and Ganesan as applied to claim 29 above, and further in view of McCoy et al. (US Patent 5,649,116, hereafter McCoy).

Re. Claim 30, neither Kolling nor Ganesan explicitly disclose a data network and an e-mail system, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment. However, McCoy disclose a data network wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment (Abstract II. 8-14). McCoy teaches a formula-based threshold for honoring a payment request when an account has insufficient assets to cover a requested payment. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Ganesan with that of McCoy in order to control risk in an automated electronic payment system (McCoy, Col. 2, I. 66 – Col. 3, I. 1).

9.   **Claim 54 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling as applied to claim 52 above, and further in view of in view of McCoy.

Re. Claim 54, Kolling do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment. However, McCoy disclose a data network wherein the financial transaction manager utilizes a growing trust model to determine whether to

honor the payment when the specified account has insufficient assets to cover the requested payment (Abstract ll. 8-14). McCoy teaches a formula-based threshold for honoring a payment request when an account has insufficient assets to cover a requested payment. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling with that of McCoy et al. in order to control risk in an automated electronic payment system (McCoy, Col. 2, l. 66 – Col. 3, l. 1).

10. **Claims 22, 23, 46 & 47 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Weatherly et al. (US Patent 6,049,784, hereafter Weatherly).
Re. Claims 22,23,46&47, Kolling disclose financial transactions with financial institutions such as banks and brokerage firms and the financial activities consumers engage in therewith (Col. 1, ll. 26-27; Col. 3, l. 20; Col. 5, ll. 50-51). Kolling do not disclose

- **Re. Claims 22&46,** a data network and an e-mail system, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant.
- **Re. Claims 23&47,** a data network and an e-mail system, wherein the assets are received from a brokerage at the request of the participant.

However, Weatherly disclose

- **Re. Claims 22&46,** a data network, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant (Col. 5, ll. 51-56).
- **Re. Claims 23&47,** a data network, wherein the assets are received from a brokerage at the request of the participant (Col. 5, ll. 51-56).

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have recognized that electronic deposits can be arranged to be made by or on behalf of any party, including individuals and businesses, and in

recognition, to have combined the art of Kolling with that of Weatherly in order to send electronically-mailed remittances in an efficient, reliable and timely manner (Weatherly, Col. 13, II. 39-42).

11.   Claims 24 & 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Weatherly as applied to claims 22 & 46 above, and further in view of Kahn.

Re. Claims 24&48, neither Kolling nor Weatherly explicitly disclose a data network and an e-mail system wherein the assets are received from an employer as compensation to the participant. However, Kahn disclose a network wherein the assets are received from an employer as compensation to the participant (Col. 12, II. 5-10). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Weatherly with that of Kahn in order to offer customers a computer automated financial management system which also provides employers with the flexibility and control of an automated standalone payroll system (Kahn, Col 4, II. 64-67).

12.   Claims 20, 21, 44 & 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Slotznick (US Patent 5,983,200).

Re. Claims 20, 21, 44 & 45, Kolling does not explicitly disclose

- **Re. Claims 20&44,** a data network and an e-mail system, wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants.

- **Re. Claims 21&45,** a data network and an e-mail system, wherein the second participant is identified by one of a name, an alias, or an email address.

However, Schlotznick discloses a data network wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants (Col. 18, II. 34-36, 51-52); and

a data network according to claim 20, wherein the second participant is identified by one of a name, an alias, or an email address (Col. 18, ll. 34-52). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Slotznick because Kolling specifically calls for incorporating Hilt et al. into Kolling's teaching to speed the execution of many tasks (Slotznick, Col. 3, ll. 48) in the providing of full-circle electronic financial transactions for billers and consumers (Kolling, Col. 4, ll. 36-38).

13.   Claims 33, 41, & 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Kahn.

Re. Claims 33, 41 & 56, Kolling do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant. However, Kahn disclose a data network and e-mail system wherein the financial transaction manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant where the participants are an employer, a payment service, the employer's bank and the employee payee who can receive a paper check instead of an electronic payment which is authorized by the employer payer (Col. 12, l. 61 – Col. 13, l. 8). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Kahn to provide flexibility in the making of an automated payment (Kahn et al., Col. 4, ll. 64-67).

14.   Claims 34 & 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling and Kahn as applied to claim 33 above, and further in view of Wells Fargo Online (See item U. in USPTO Form 892).

Re. Claim 34&57, neither Kolling nor Kahn explicitly disclose a data network and an e-mail system wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an

account. However, Wells Fargo Online discloses since 1997 the inclusion of a URL
where the recipient can establish an account. The enclosed screen shots from Wells
Fargo Online's URL are dated 1998. The Examiner has been doing business with Wells
Fargo Bank in the San Francisco area since 1991 and has personally received a wide
variety of WFB promotional material, computer printed statements, business cards and
letterhead in the mail, at bank branches and from bank employees with the URL
imprinted on them at least since the late 1990's. URL's became a standard component
of contact information in American business, including in banking, during the 1990's. A
bank issuing payroll checks would be a bank where the recipient could establish an
account. It would have been obvious to an ordinary practitioner of the art at the time of
Applicant's invention to have included a bank's URL with a bank's address information
on electronic or paper checks to convey a means of contact which has become
increasingly popular in banking and the general business community during the 1990's
in order to attract some of the growing millions of computer users to online banking with
its own institution by presenting a convenient opportunity to do so. It would have been
obvious to an ordinary practitioner of the art at the time of Applicant's invention to have
combined the art of Kolling and Kahn with that of the Wells Fargo Online art to include
URL addresses in the providing of full-circle electronic financial transactions for billers
and consumers (Kolling, Col. 4, ll. 36-38).

15.   **Claims 35 & 58 are rejected** under 35 U.S.C. 103(a) as being unpatentable over
Kolling in view of Kahn and Wells Fargo Online as applied to claims 34 & 41 above, and
further in view of Krishan et al. (US Patent 6,442,529 B1, hereafter Krishan).
Re. Claim 35, 42 & 58, none of Kolling, Kahn or Wells Fargo disclose a data network
and an e-mail system, wherein the check includes an offer of free assets, credited to a
newly established account created by the recipient of the check. However, Krishan
disclose the long established practice of offering a free service product as an incentive
for a prospect to try a service (Front Page, OTHER PUBLICATIONS: Simon Debartol,
"Microsoft to Offer Free Internet to 32 Million Michigan Households", Indianapolis Star

and News, Dec. 02, 1997.). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the teachings of Kolling, Kahn and Wells Fargo with the teaching of Krishan in order to include the printing of an offer of free assets on a check, credited to a newly established account created by the recipient of the check as a method of providing advertising and information content on a user's desktop screen (Krishan, Col. 3, ll. 16-18).

16.   Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Kahn as applied to claim 41 above, and further in view of Krishan.

Re. Claim 42, neither Kolling nor Kahn disclose a data network and an e-mail system, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check. However, Krishan disclose the long established practice of offering a free service product as an incentive for a prospect to try a service (Front Page, OTHER PUBLICATIONS: Simon Debartol, "Microsoft to Offer Free Internet to 32 Million Michigan Households", Indianapolis Star and News, Dec. 02, 1997.). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the teachings of Kolling and Kahn with the teaching of Krishan in order to include the printing of an offer of free assets on a check, credited to a newly established account created by the recipient of the check as a method of providing advertising and information content on a user's desktop screen (Krishan, Col. 3, ll. 16-18).

(10) Response to Argument

Applicant's arguments filed on September 17, 2007 as an Appeal Brief with respect to claims 1-59 are addressed in the above rejection of claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully,

Siegfried Chencinski

Conferees:

Vincent Millin, Appeal Specialist

Alexander Kalinowski, SPE

Siegfried Chencinski, Patent Examiner